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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,729	07/16/2001	Jean-Rene Rousseau	Q063000	7013

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EXAMINER

HARRY, ANDREW T

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/773,729

Applicant(s)

ROUSSEAU, JEAN-RENE

Examiner

Andrew T Harry

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: the specification fails to contain section headings.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-4 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by *Doviak et al.*, U.S. Patent 6,418,324 (“*Doviak*”).**

As pertaining to **claim 1**, *Doviak* teaches telecommunication equipment for setting up local telephone connections between at least one mobile telephone belonging to a private network and a public network (see *Doviak*, abstract), the equipment including:

a downstream radio access system for setting up a link to a base transceiver station of a public mobile telephone network (see *Doviak*, Fig. 1, and col. 33 lines 14-32); and

an upstream radio access system for setting up a link to a mobile telephone of the private network (see *Doviak*, Fig. 1, and col. 33 lines 14-32);

characterized in that the upstream system and the downstream system apply the same mobile telephone standard, which is that of the public mobile telephone network (see *Doviak*, col. 32, line 45-col. 33, line 32),

and in that it further includes a service signal converter module between the upstream system and the downstream system (see *Doviak*, col. 33, lines 32-41) adapted to:

repeat signals it receives from the upstream and downstream systems and adapt them to suit the characteristics of the downstream and the upstream link respectively (see *Doviak*, col. 33, lines 14-56), and

extract from the signaling information specific to the mobile telephones belonging to the private network and used to manage calls between the terminals of the private network and store that information in a local database. See *Doviak*, col. 36, line 65-col. 37, line 13.

As pertaining to **claims 2 and 3**, in *Doviak's* system the downstream system includes means for simulating mobile terminal links and the upstream system includes means for simulating base transceiver station links. See *Doviak*, Fig. 1, and col. 33, lines 14-41.

As pertaining to **claim 4**, in *Doviak's* system the downstream system includes a plurality of modules for identifying public mobile telephone network users, and in that the converter module includes means for choosing one or more identification modules. See *Doviak*, col. 35, line 37-51, in *Doviak's* device each user module has specific parameters detailing the parameters by which the user would like to operate and *Doviak's* device is configured to interpret this user profile and choose the appropriate identification module.

As pertaining to **claim 7**, in *Doviak's* system the upstream system could include means for connecting to a landline telephone. See *Doviak*, Fig. 1, and col. 33 lines 14-32.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Doviak* as applied to claim 1 above, and further in view of well known prior art at the time of the invention.**

As pertaining to **claims 4-6**, *Doviak* teaches that a user configuration is stored in the system for each user and that this user configuration is capable of storing various user parameters. See *Doviak*, col. 35, line 37-51. However, *Doviak* fails to specifically describe that modules are controlled in accordance with a criterion related to a users contract and whether the device can detect that the user of a mobile telephone terminal has a contact with the GSM public network and for carrying out transfer without using any of the subscriber resources of the downstream system. The Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time of the invention that the above-mentioned parameters and methods could have easily been added to *Doviak's* device with little effort. The addition of these functionalities and user profile parameters would have allowed the user of the device to be better suited to operate on a GSM system instead of operating in the generic manner as it is currently described.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Harry whose telephone number is 703-305-4749. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ATH



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